

Application No. 10/029,313

### **REMARKS**

The Office Action noted that the Oath and Declaration implies that the specification and claims were filed on 12/28/02 as U.S. Application No. 10/029,313. The Office Action is correct in noting that application has a filing date of 12/28/01. A copy of the filing receipt is attached to confirm that the filing date was 12/28/01. This is clearly a typographic mistake since the oath correctly identifies the application number.

In the specification, applicant was reminded of the proper content of an abstract of the disclosure. In response, the Abstract has been amended to delete the words "improved" and "efficient" as well as a sentence describing certain advantages of the invention.

Claims 1-29 are pending.

Claims 5-7 and 10-29 have been withdrawn by Examiner's action over traverse by Applicant.

Claims 1-4, 8 and 9 have been rejected.

Claim 30 is newly added.

In the election restriction, Applicant elects claims 1-4, 8 and 9 with continued traverse.

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**ELECTION /RESTRICTION**

Applicant reiterates his strong objection that this restriction requirement is unreasonable and not based on a requirement to perform multiple searches. As an example, claims 5-7 do NOT introduce any new elements to the elements introduced in claims 1-4, 8 and 9. Claims 5-7 and 10-11 instead deal with positioning of the elements introduced in Claim 1. Similarly, claims 12-14 do not introduce any new elements but instead simply describe the operation of the controller limitation of Claim 1. Applicant believes he is entitled to know what new searches, if any, are required to deal with these dependent claims that introduce no additional elements. Applicant again reiterates that linking claims 28 and 29 should prevent restriction of claims 26 and 27 from the elected claims. Applicant again notes that each of the elements of claim 26 are identical to the elements of claim 1. Only the preamble to claim 26 differs from the preamble of claim 1 by adding that the punch apparatus of claim 1 comprises a subsystem of a marking system. **The effect, therefore, is that Claim 26 is equivalent to a claim dependent from claim 1 since use in a marking device is a further limitation upon the element of claim 1.** As a matter of interest and as proof of Applicant's position, Applicant seeks an explanation of the Art Group that would handle Claims 26-27 in the event these were filed separately. If these Claims would be assigned to the same Art Group, then the Office Action's argument that additional searches are required appears, frankly, specious. Applicant accordingly strongly resists the Restriction Requirement and desires that Claims 26-27, at a minimum be restored and that the proposed amendment in Claim 27 be entered

Claims 1-4 and 8-9 were rejected under 35 USC §-102(e) as being anticipated by Holzhauser et al., U.S. Patent 6,295,908. In response, Applicant notes that the Office Action cites and relies upon Column 2, lines 25-45, column 4, lines 1-15 and 30-47, and column 5, lines 9-40, for the proposition that "rotation is timed such that the other punch intersects the sheet path in a space between

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pitches" as required by element (e) of Claim 1. A review of each of these cited sections of Holzhauser reveals that the described function is NOT taught, described, or implied in these sections or any other section of Holzhauser. Indeed, language in Holzhauser not cited in the Office Action specifically *teaches away* from the claimed invention:

After the holes are punched in the medium and one set of punching studs 22 or 24, withdraws from the corresponding set of recesses 32a or 34a, MPU 60 controls motor driver 68 to **cease rotating** the shafts 20, 30 so that the subsequent set of punching studs and recesses will not engage the medium. **After** the trailing edge of the medium P has passed through the punching unit by conveyance of discharging rollers 56, 58, the shafts of punching unit 10 can either be forwardly or reversely rotated to their original positions. Holzhauser, column 5, lines 41-49 (emphasis added)

In other words, Holzhauser is clear that rotation of the punches does NOT continue and is NOT timed to intersect the sheet path in a space between pitches. Instead, rotation is halted after the punch is disengaged from the media. Rotation begins again in Holzhauser's invention in either direction in order to make the next strike. No intersection with the paper path is made between pitches. Holzhauser thus teaches directly away from the instant invention and cannot support a rejection under 35 U.S.C. §102(e). Claims 1-4 and 8-9 were rejected under 35 USC § 102(e) as anticipated by Japanese application 2000-169890, hereinafter JP '890, or, in the alternative, under 35 USC §103(a) as obvious over JP '890 in view of Holzhauser. In response, Applicant notes that JP '890 also teaches directly away from the present invention by teaching that dies and punches of JP '890 are "returned to the waiting positions after detecting a paper end by a paper end detecting means." (See JP '890 Abstract). This is opposite to the requirement of Claim 1 of Applicant's invention requiring that "rotation is timed such that the other

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punch intersects the sheet path in a space between pitches". As indicated above, Holzhauser cannot support a rejection under either 35 USC §102(e) or 35 USC §103(a) since it explicitly *teaches away* from the present invention. Indeed, the inventions in Holzhauser and JP '890 each require a different mechanism and controller than Applicant's invention. In Holzhauser, not only does the mechanism need to *prevent* the second punch set from intersecting the paper path between pitches, it also must be able to rotate the active punch set in *both* a forward and a reverse direction. In Applicant's invention, the shaft need only rotate in one direction. The mechanism for Applicant's invention is thus simpler than the mechanism in Holzhauser.

In sum, neither Holzhauser nor JP '890 can support either a rejection under 35 USC §102(e) or 35 USC §103(a) since both explicitly teach away from Applicant's invention and since both require a different mechanism than Applicant's invention.

Accordingly, Claim 1 is allowable over Holzhauser. Since Claims 2-24 and Claims 28 and 29 each depend directly or indirectly from Claim 1, these claims also are allowable. Additionally, as noted above, Claims 26 and 27 also are allowable since these claims contain all of the limitations of Claim 1 plus, in addition, are limited to hole punches located in marking systems.

Claim 30 is added to focus on yet another difference between Applicant's invention as shown in Figure 1 and the devices shown in Holzhauser and JP '890. Specifically, an advantage of the apparatus claimed in Claim 30 is that at least some of the first punches will be aligned with second punches, thereby enabling a single punch tool to be used for both a first and a second punch. This enables easier installation and removal of punch members since removal and handling of a single tool for maintenance or replacement results in the simultaneous removal and handling of two punches. As seen in the Figures for both Holzhauser and JP '890, the punch tools are offset from each other. The apparatus claimed in

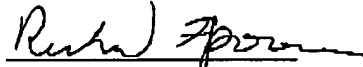
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Claim 30 is thus both novel and non-obvious when compared to the apparatus shown in Holzhauser and JP '890. Claim 30 is thus allowable.

The application and claims are believed to be in a condition for allowance in their present form and which allowance is respectfully requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Applicant's Attorney, Richard Spooner, at Telephone Number (585) 423-5324, Rochester, New York.

Respectfully submitted,



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